In the Supreme Court of the United States

OCTOBER TERM, 1944

No. 665

LINE MATERIAL COMPANY, A CORPORATION, AND WILLIAM O. SCHULTZ, PETITIONERS

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

MEMORANDUM FOR THE COMMISSIONER OF PATENTS

OPINIONS BELOW

The memorandum opinion of the United States District Court for the District of Columbia (R. 12–13) is not reported. The opinion of the United States Court of Appeals for the District of Columbia (R. 129) is reported in 144 F. (2d) 518.

JURISDICTION

The judgment of the District Court was entered on January 18, 1943 (R. 16–17). The judgment of the Court of Appeals was entered on July 10, 1944 (R. 130). A petition for rehearing was

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denied on August 12, 1944 (R. 131). The petition for a writ of certiorari was filed on November 11, 1944. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTION PRESENTED

Whether the United States District Court for the District of Columbia has jurisdiction under Rev. Stat. 4915 (35 U. S. C. 63) over a suit to compel the Commissioner of Patents to allow certain claims which had been rejected by the Patent Office, where the court, if it reversed the Patent Office, could not then order issuance of a patent, since further proceedings in the Patent Office would still be required.

STATUTE INVOLVED

The relevant portion of the statute is set forth in the Appendix, pp. 6–7, *infra*.

STATEMENT

On May 24, 1934, petitioner, William O. Schultz, filed an application in the United States Patent Office for a patent on an electrical fuse construction. While the application was pending, petitioner, Schultz, and his assignee, Line Material Company (also petitioner herein), added to the application three claims copied from another application in order to provoke interference proceedings (R. 2–3, 9, 119). Five such proceedings resulted

therefrom, but, on June 10, 1937, were dissolved as to petitioners on the ground that the copied claims were not supported by the specification in the Schultz application (R. 4–5, 9, 119–120). Thereafter, pending an unsuccessful appeal to the Board of Appeals (R. 117–125), petitioners filed an amendment to their specification, and a supporting supplemental oath (R. 5, 9, 120). Upon *ex parte* consideration of the application (and after allowance of forty-nine other claims in the application (R. 117)), the Primary Examiner finally rejected the three copied claims and required cancellation of the amendment to the specification, on the ground that they "involved new matter" (R. 5, 10).

Following affirmance of this ruling by the Board of Appeals (R. 5, 10, 122), petitioners brought suit against the Commissioner of Patents under Section 4915 of the Revised Statutes (35 U. S. C. 63) in the United States District Court for the District of Columbia, to direct the Commissioner to allow the three rejected claims and to allow the amendment to be made to the specification (R. 1–9). After receiving in evidence the record before the Patent Office and additional evidence on behalf of petitioner (R. 20–80), the District Court rendered a memorandum opinion (R. 12–13), and entered findings of fact and conclusions of law on January 18, 1943, dismissing the complaint on the ground that the appealed

claims were not supported by the disclosure of the original application (R. 13–17).

On appeal, the United States Court of Appeals for the District of Columbia affirmed, *per curiam*, the dismissal of the complaint, under the authority of *Hoover* v. *Coe*, 144 F. (2d) 514 (App. D. C.), decided the same day, certiorari granted, November 6, 1944 (R. 129). After observing that "The effect of a decision in appellants' favor can only be to reinstate them in the interference proceedings," the court below concluded "If we reversed the administrative rulings of the Patent Office it would still be impossible to adjudge that appellants were entitled to a patent because that question would then depend on whether they had priority over the other parties to the interference who are not before this court." (R. 129.)

DISCUSSION

The question presented is essentially the same as that involved in *Hoover* v. *Coe*, 144 F. (2d) 514 (App. D. C.), certiorari granted, November 6, 1944.[1] There is a factual distinction between the two cases in that the copied claims in the *Hoover* case were disallowed before any interference was declared as to such claims. In each case, however, the claims were finally rejected for want of support in the applicant's disclosure. For

[1] In the *Hoover* case, a memorandum was filed in behalf of the Commissioner not opposing the petition for a writ of certiorari.

the reasons stated in our memorandum submitted in the *Hoover* case, we do not oppose the petition for a writ of certiorari.

Respectfully submitted.

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FRANCIS M. SHEA,
Assistant Attorney General.

DAVID L. KREEGER,
Special Assistant to the Attorney General.

JOSEPH B. GOLDMAN,
Attorney.

DECEMBER 1944.

APPENDIX

Section 4915 R. S., as amended (35 U. S. C. 63) provides as follows:

> SEC. 4915. Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of

either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

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